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7590 02/10/2011 FELLERS, SNIDER, BLANKENSHIP, BAILEY & TIPPENS, PC 100 BROADWAY SUITE 1700 OKLAHOMA CITY, OK 73102-8820			EXAMINER SHELEHEDA, JAMES R	
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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/760,242
Filing Date: January 12, 2001
Appellant(s): DAVIDSON, ROBERT J.

Mitchell K. McCarthy
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11/30/10 appealing from the Office action mailed 04/13/10.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1-5, 8,9, 11-15, 19,20, 24-26, 32 and 37-39 are rejected and pending.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

6,628,963	Chung	09-2003
7,266,202	Kawakami et al.	09-2007
6,651,212	Katayama et al.	11-2003
6,226,618	Downs et al.	05-2001
5,557,596	Gibson et al.	09-1996

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Art Unit: 2424

Claims 1-5, 8, 19, 20, 24, 25, 32, 37 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chung (6,628,963) (of record) in view of Kawakami et al. (Kawakami) (7,266,202) (of record).

As to claim 1, while Chung discloses a method of portably handling entertainment media (column 1, lines 5-12) comprising:

storing in a memory of a portable digital storage module non-encoded entertainment media that is not encoded with any authorized usage condition (column 1, lines 37-40, column 2, line 56-column 3, line 20),

he fails to specifically disclose after the storing step is completed, encoding the portable digital storage module with access instructions defining a prescribed authorized usage condition of the stored non-encoded entertainment media.

In an analogous art, Kawakami discloses a content delivery system (see Fig. 1) wherein non-encoded digital content is downloaded onto a portable media player (Fig. 3; column 6, lines 32-55) and a programmable controller is programmed with access instructions corresponding to a predefined limit of authorized playings of the entertainment media are (Fig. 3; column 8, lines 11-23 and column 12, lines 50-55) after the storing step is completed (Fig. 19) for the typical benefit of ensuring that the rights of content owners are secured in a digital content distribution system (column 1, lines 7-67).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Chung's system to include after the storing step is completed, encoding the portable digital storage module with access instructions

Art Unit: 2424

defining a prescribed authorized usage condition of the stored non-encoded entertainment media, as taught in combination with Kawakami, for the typical benefit of ensuring that the rights of content owners are secured in a digital content distribution system.

As to claim 2, Chung and Kawakami disclose wherein the storing step further comprises transferring a copy of the non-encoded entertainment media from a purchase center into the memory of the portable digital storage module (see Kawakami at column 6, lines 20-32 and column 16, lines 35-60).

As to claim 3, Chung and Kawakami disclose wherein the storing step further comprises downloading the non-encoded entertainment media from a remotely located database (see Kawakami at column 6, lines 20-32 and column 16, lines 35-60).

As to claim 4, Chung and Kawakami disclose repeating the storing the entertainment media step to store two or more non-encoded entertainment media into the memory of the portable digital storage module (downloading and storing a plurality of movie files; see Chung at column 1, lines 5-12, lines 37-40 and column 2, lines 55-62).

As to claim 5, Chung and Kawakami disclose wherein the retrieving step is characterized by the digital format player device including a personal movie player (portable multimedia player; see Chung at Figs. 1 and 2; column 1, lines 20-30).

As to claim 8, Chung and Kawakami disclose wherein the storing step is performed in a broadband frequency format (MPEG format; see Chung at column 2, line 35 - column 3, line 11).

As to claim 19, Chung and Kawakami disclose wherein the encoding step is characterized by the prescribed authorized usage condition granting permission to playback the stored non-encoded entertainment media a finite number of times (see Kawakami at column 8, lines 17-24).

As to claim 20, Chung and Kawakami disclose wherein the encoding step is characterized by the prescribed authorized usage condition granting permission to playback the stored non-encoded entertainment media within a finite period of time (see Kawakami at column 11, lines 19-28).

As to claim 24, Chung and Kawakami discloses wherein the storing step is characterized by the non-encoded entertainment media comprising audio data (see Chung at column 1, lines 6-14).

As to claim 25, Chung and Kawakami disclose wherein the storing step is characterized by the non-encoded entertainment media comprising video data (see Chung at column 1, lines 6-14).

As to claim 32, Chung and Kawakami disclose wherein the encoding steps is characterized by automatically deleting the stored non-encoded entertainment media from the memory according to the prescribed authorized usage (see Kawakami at column 26, lines 1-20).

As to claim 37, Chung and Kawakami disclose retrieving the stored non-encoded entertainment media from the memory of the portable digital storage module with a digital format player device in accordance with permission granted by the access instructions (see Kawakami at column 8, lines 11-23).

As to claim 39, Chung and Kawakami disclose after a request for usage of the stored non-encoded entertainment media, changing the encoded access instructions and thereby changing the prescribed authorized usage condition of the stored non-encoded entertainment media in relation to the request for a usage of the stored non-encoded entertainment media (see Kawakami at column 8, lines 18-24 and column 11, lines 19-28).

Art Unit: 2424

Claims 9 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chung in view of Katayama et al. (Katayama) (6,651,212) (of record) and Kawakami.

As to claim 9, while Chung discloses a portable digital storage module (column 2, lines 55-62 and column 1, lines 37-40) comprising:

- an enclosure that is removably engageable with each of a plurality of digital devices (flash memory or multimedia card; Fig. 3; column 2, lines 56-62) in a data transfer relationship (see Fig. 3; column 2, lines 50-60 and column 1, lines 34-40 and lines 56-62),

- a memory in the enclosure (column 2, lines 50-62),

- an interface configured to operably communicate with a first digital device of the plurality of digital devices to store to the memory of non-encoded entertainment media that is not encoded with any usage condition (inherently present as the memory device interfaces with and communicates with the digital device; column 1, lines 37-40, column 2, line 56-column 3, line 20), he fails to specifically disclose a controller in the enclosure configured to respond to access instructions that are encoded to the digital storage module via the interface after the non-encoded entertainment media has been stored to the memory to enable the interface to operably communicate with a second digital device of the plurality of digital device to playback the non-encoded entertainment media in accordance with a prescribed authorized usage condition.

In an analogous art, Katayama discloses wherein a removable flash memory device (Fig. 1; 101) comprising controller logic (102) for operating the storage device and communicating between the memory component (111-114) and the

communications interface (105-106) (Fig. 1; column 10, lines 10-37), the communication interface (see Katayama at Fig. 1) subject to the programmable controller (Fig. 1; column 10, lines 13-37) in transferring data from the memory to the digital format player device (see Katayama at Fig. 1; column 10, lines 13-37) for the typical benefit of reducing the size and weight of the memory by integrating the controller and memory into a single chip (column 2, lines 17-23).

Additionally, in an analogous art, Kawakami discloses a content delivery system (see Fig. 1) wherein digital content is downloaded onto a portable media player (Fig. 3; column 6, lines 32-55) and a programmable controller is programmed with access instructions corresponding to a predefined limit of authorized playing of the entertainment media (Fig. 3; column 8, lines 11-23 and column 12, lines 50-55) after the storing step is completed (Fig. 19) for the typical benefit of ensuring that the rights of content owners are secured in a digital content distribution system (column 1, lines 7-67).

It would have been obvious to one of ordinary skill in the art at the time of invention to modify Chung's system to include a controller in the enclosure for executing instructions stored in the memory, as taught in combination with Katayama, for the typical benefit of reducing the size and weight of the memory by integrating the controller and memory into a single chip.

Additionally, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Chung and Katayama's system to include access instructions that are encoded to the digital storage module via the interface to

Art Unit: 2424

enable the interface to operably communicate with a digital device to playback the non-encoded entertainment media in accordance with a prescribed authorized usage condition, after the storing step is completed, as taught in combination with Kawakami, for the typical benefit of ensuring that the rights of content owners are secured in a digital content distribution system.

As to claim 15, Chung, Katayama and Kawakami disclose wherein the memory is configured for subsequently storing data wherein different data was previously stored (see Chung at column 2, lines 56-62).

Claims 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chung, Katayama and Kawakami as applied to claim 9 above, and further in view of Gibson.

As to claim 11, while Chung, Katayama and Kawakami disclose a memory, they fail to specifically disclose wherein the memory is characterized as an atomic resolution storage device comprising:

- a field emitter fabricated by semiconductor micro fabrication techniques capable of generating an electron beam current; and

- a storage medium in proximity to the field emitter and having a storage area in one of a plurality of states to represent the information stored in the storage area.

In an analogous art, Gibson discloses the use of an atomic resolution storage device (Figs. 1A-C; column 1, line 63-column 2, line 33) as opposed to conventional storage technologies (column 1, lines 14-21), the atomic resolution storage device

Art Unit: 2424

comprising a field emitter fabricated by semiconductor micro-fabrication techniques capable of generating an electron beam current (see Gibson at column 2, line 65 - column 3, line 29), and a storage medium in proximity to the field emitter and having a storage area in one of a plurality of states to represent the information stored in the storage area (see Gibson at column 3, lines 1-5) for the typical benefit of providing ultra-high density storage with fast access times and high data rates (column 1, lines 52-62).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Chung, Katayama and Kawakami's system to include wherein the memory is characterized as an atomic resolution storage device comprising: a field emitter fabricated by semiconductor micro fabrication techniques capable of generating an electron beam current; and a storage medium in proximity to the field emitter and having a storage area in one of a plurality of states to represent the information stored in the storage area, as taught in combination with Gibson, for the typical benefit of taking advantage of the benefits provided by an atomic resolution storage device, such as fast access times and high data rates combined with ultra-high density storage.

As to claim 12, Chung, Katayama, Kawakami and Gibson disclose an effect being generated when the electron beam current bombards the storage area, wherein the magnitude is dependent on the state of said storage, and wherein storage data is read by measuring the magnitude of the effect (see Gibson at column 5, line 64 - column 6, line 10).

As to claim 13, Chung, Katayama, Kawakami and Gibson disclose the atomic resolution storage module further comprising a plurality of storage areas on the storage medium, each storage area in one of a plurality of states to represent information stored in the storage area (see Gibson at column 5, line 64 – column 6, line 10), and a micro fabricated mover in the storage device for positioning various areas to be bombarded by the electron beam current (see Gibson at column 6, lines 2-10).

As to claim 14, Chung, Katayama, Kawakami and Gibson disclose the atomic resolution storage module further comprising a plurality of said field emitters (see Gibson at column 2, line 65 - column 3, line 5), with each emitter fabricated by semiconductor micro fabrication techniques capable of generating an electron beam current (see Gibson at column 3, lines 5-20), with each emitter space apart, and with each emitter being responsible for a number of storage areas such that said emitters can function in parallel to increase the data rate of the storage device (see Gibson at column 3, line 57 - column 4, line 20).

Claims 26 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chung and Kawakami as applied to claim 1 above, and further in view of Downs et al. (Downs) (6,226,618) (of record).

As to claim 26, while Chung and Kawakami disclose storing access instructions and a purchase price, they fail to specifically disclose wherein the encoding step is

characterized by a predetermined association between a user-selected purchase price for the non-encoded entertainment media and the corresponding authorized usage.

In an analogous art, Downs discloses a content delivery system (see Figs. 1A-D) wherein digital content is downloaded onto a portable media player (column 6, lines 35-48) which is encoded with access instructions corresponding to a predefined limit of authorized playing of the entertainment media (column 11, lines 30-55 and column 7, lines 41-55) wherein the access instructions are characterized by a predetermined association between a user-selected purchase price for the entertainment media and the corresponding authorized usage (usage tables; see Downs at columns 59 and 61) for the typical benefit of providing the user with more flexibility in accessing their desired content within the desired manner (see Downs at columns 59 and 61).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Chung and Kawakami's system to include wherein the programming access instructions steps is characterized by a predetermined association between a user-selected purchase price for the entertainment media and the corresponding authorized usage, as taught in combination with Downs, for the typical benefit of providing the user with more flexibility in accessing their desired content within the desired manner.

As to claim 38, Chung, Kawakami and Downs disclose the user selected purchase price being determined by a users input to a point of purchase system (see Downs at usage tables, column 59 and column 61), wherein the stored non-encoded

entertainment media resides in the memory of the digital storage module prior to the user's input (see Downs at column 78, lines 28-67 and Kawakami at Fig. 19).

(10) Response to Argument

On pages 6-8, appellant argues that the plain meaning of claim 1 is that the encoding step writes the access instructions to the module but not to the already stored non-encoded entertainment media.

In response, it is noted that appellant is twisting the claim language in an attempt to claim subject matter which is not supported by the application as originally filed, as which has been repeatedly rejected as such in prior office actions.

While appellant's specification discloses storing access instructions in the module (page 5, lines 10-32), there is no support for encoding the module without encoding the stored entertainment media. The specification is silent as to how and where the access instructions are stored within the module. There is no specific disclosure of what method is used to "encode" the access instructions within the module (page 5, lines 28-31) and whether or not the media programs are modified or encoded.

In the Final Rejection mailed 08/26/08, claim 9 was rejected as it was indicated that the limitation "store access instructions separately from the entertainment media in the memory such that the access instructions are not embedded in the entertainment media" was not supported by appellant's specification as originally filed. As shown

above, the specification is silent as to the encoding method used and to whether the instructions are encoded into the entertainment media.

In the Non-Final Rejection mailed 03/10/09, claims 1 and 9 were rejected as it was indicated that the limitation “programming access instructions without modifying the previously stored entertainment media in the memory” was not supported by appellant’s specification as originally filed. As shown above, the specification is silent as to the encoding method used and to whether the instructions are encoded into the entertainment media.

The claims were then amended in response to that rejection (appellant’s response 04/05/10) to remove the limitations directed to storing the access instructions without modifying the entertainment media.

Appellant is now attempting to argue that these unsupported, unclaimed, features are required by the claim language.

The current claims, however, indicate that “non-encoded entertainment media” is first stored, and that after that non-encoded entertainment media is stored, then access instructions are encoded into the storage. Thus, the claims merely require that the entertainment media be stored **prior** to the access instructions. Once the entertainment media is fully stored, the access instructions can then be encoded onto the storage. The claims do not require that the entertainment media **stay** unencoded with authorized usage conditions, but merely that they are stored first without the usage conditions. As

Art Unit: 2424

already shown, appellant's specification provides no support for storing the usage conditions separately from the media content and requiring the media content to remain "non-encoded". No guidance whatsoever is provided as to what technique is used to encode the access instructions onto the storage module (see page 5, lines 28-page 6, line 2).

Furthermore, it is noted that on page 9 of the appeal brief, appellant readily admits that appellant's specification is silent as to the specific encoding method used as "The skilled artisan having read the specification readily understands how the featured encoding the portable digital storage module is achieved by writing access instructions to the memory 50, not necessarily the already stored non-encoded entertainment media...".

The examiner agrees that the access instructions are not ***necessarily*** embedded within the entertainment media, but that this is merely one possible way to achieve the encoding step. As appellant's specification provides no indication of any particular encoding method, and certainly never precludes any particular method, the skilled artisan having read the specification would have readily understood that one viable and well known method was to encode the access instructions for an entertainment media into the entertainment media.

Appellant's arguments, however, attempt to indicate that claims require one particular encoding method which was never disclosed within the specification as originally filed.

On pages 9-10, appellant argues that in Kawakami the usage conditions are transferred to the portable device with the content, and that the usage conditions are not stored after the content is stored.

In response, Kawakami explicitly shows in Figs. 13 and 19, where the content data is transferred to the portable device first, and after the content data is stored in the portable device (steps 59-60 and 119-120), the usage conditions are then transferred and stored into the portable device (steps 61-64 and 122-123).

On pages 9-10, appellant argues that Kawakami transfers data in the form of a "packet" that accompanies the content with a header containing the usage condition.

In response, it is noted that Kawakami actually discloses transmitting the data in a plurality of 64 byte packets (column 10, lines 28-31). The "header" he refers to as including all of the non-content data is shown as an example as itself 33 bytes (column 10, lines 40-42). The content file, is given as an example of consisting of 33,636,138 bytes (column 10, lines 40-42). Any assertion that the data merely consists of a packet is simply incorrect, as the content file size would require at least 552,564 packets to transmit all of the data. The usage of the term "header" in this context is not regarding a packet header, as is simply a reference to the types of data included within it. This is further seen, as shown above, that the content data is transmitted first prior to this "header" data (Fig. 13 and 19).

As seen in Fig. 4, the content data and the usage rules are completely separate files (content files 161-1 thru 162-N and usage rule files 162-1 thru 162-N). The content files (161-1 thru 161-N) are then transferred after checking the separate usage rule files (column 14, lines 46-51). The content data and usage data are explicitly disclosed as being separate files which are separately processed and transferred.

On page 11, appellant argues that there is nothing within Kawakami that would lead the skilled artisan to believe that block S119 (of Fig. 19) transfers only the content, and not the usage rules and content together.

In response, the skilled artisan would believe that block S119 (of Fig. 19) transfers only the content as the usage rules (playback conditions) are explicitly shown as being transmitted in a later step.

In step 119 the content is transferred to the portable device and in step 120 the content is stored in the portable device.

In step 123 the playback conditions are transferred to the portable device. There is absolutely no reason to assume the usage rules are transferred with the content, when the specification explicitly shows them being transferred at separate times (Fig. 13 and 19; column 27, line 49-column 28, line 10).

In response to appellant's arguments on page 11 that the transferred data is "packetized" to include the header with the associated content, see above where it has already been shown that Kawakami does not ever require the usage rules to be

transmitted with the content data and that appellant's interpretation of the "packet" and header are incorrect. The usage rules and content are stored in completely separate data files (as seen in Fig. 4; column 17, line 50-column 18, line 9) and are not, and could not, be contained within a single packet.

In response to appellant's arguments on page 12, it is noted that none of the passages of Kawakami cited by appellant say anything whatsoever regarding transmitting the content and the usage rules together, as appellant suggests.

The first citation, column 8, lines 11-14, merely indicates that the content is "stored along with" the usage rule data. This does not somehow require, as appellant suggests, that the data must have been transmitted together as a single packet.

As shown above, both pieces of information are separately transferred to the portable device, with the content transmitted prior to the usage rules (Fig. 13 and 19; column 27, line 49-column 28, line 10). This is wholly consistent with the language of "stored along with" that appellant has pulled out of context from Kawakami, as both pieces of data are eventually stored in the portable device together. Any other data stored in the portable device would also happen to be "stored along with" the content data and the usage rules, but this would not mean that it was all simultaneously transmitted.

The second citation, column 10, lines 23-27, merely indicates that the USB controller supplies data "including a content". This does not somehow require, as

Art Unit: 2424

appellant suggests, that the “data” is a single data file including all of the different pieces of data transmitted together.

As shown above, the content data and the usage rules are separate data files (see Fig. 4; column 17, line 50-column 18, line 9) which are separately transferred to the portable device, with the content transmitted prior to the usage rules (Fig. 13 and 19; column 27, line 49-column 28, line 10). This is wholly consistent with the language of “supply data including a content” that appellant has pulled out of context from Kawakami, as all of the data being transferred from the computer to the portable device passes through the USB connector. Any other data, such as additional content items (content files 161-1 thru 161-N) would also be supplied to the portable device through the USB connector, but this would not mean that it was all simultaneously transmitted.

In response to appellant’s further arguments on pages 13-23, please see above as these arguments are based upon the same flawed reasoning regarding the teachings of Kawakami.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Art Unit: 2424

/James Sheleheda/

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